

The claim language that is paraphrased by the Office action is fairly representative of the claimed features within the independent claims, e.g., using independent claim 1 as an exemplary claim:

- 5 1. A method of processing a document object model (DOM) tree having a tag located at a given node in the tree, comprising the steps of:
- 10 upon encountering the tag, passing given information to a method in a tag handler, wherein the tag handler is registered in a tag library, wherein the tag library contains one or more elements defining tags, wherein an element defining the tag contains an attribute for the tag handler that processes an instance of the tag;
- 15 having the method generate a string;
- parsing the string into a new DOM tree; and
- replacing the given node and any child nodes with the new DOM tree.

With respect to the argument in the Office action that

20 certain claim features "are not disclosed in the 'Idea of a Disclosure' statement" of "Invention Disclosure form AUS8-1999-0727", Applicant has filed herewith another inventor's declaration under 37 C.F.R. § 1.131, as noted hereinabove. This newly filed inventor's declaration is similar to the previously

25 filed inventor's declaration with respect to the important facts that the inventor declares that Applicant's claimed invention was completed and reduced to practice prior to August 18, 1999, as shown in the supporting evidentiary document, i.e. the disclosure document titled "Disclosure AUS8-1999-0688". Applicant asserts

30 that the newly filed "Disclosure AUS8-1999-0688" document addresses the argument in the Office action such that Applicant has now shown that Applicant conceived of the present invention as claimed before the publication date of the primary reference that has been used in the obviousness rejection against the

35 claims in the present invention.

If the Office action is arguing that no elements in claim 1 are found within "Invention Disclosure form AUS8-1999-0727", Applicant strongly disagrees. For example, "Disclosure AUS8-1999-0727" states the following in its "Idea of disclosure" section:

There is a further simplification we can make for the tagbean writer: pass in an XML string.

This simplification doesn't require the writer to know anything about the DOM APIs.

If the tag requires simple token replacement, the tagbean writer will find it way too cumbersome to perform the replacement when constrained to only looking at the text in small chunks of the attribute values and text inside of nodes.

```
public abstract class TextTagBean extends SimpleTagBean
{
```

```
    public abstract String
    translateText(String input);
```

```
    public final String
    translateElement(Element element);
```

```
    public final void
    process(Element element);
```

```
}
```

The TextTagBean extends the SimpleTagBean class and implements the translateElement function to inherit the String --> DOM output functionality.

The TextTagBean performs as follows:

1. The Java TagBean handler calls SimpleTagBean.process(element).

2. SimpleTagBean.process hands the element off to the "overwritten" translateElement() method.

3. TextTagBean.translateElement() takes the element and flattens it into XML without interpreting any of the XML.

4. The XML is passed to the translateText method.

5. translateText looks at the XML string and manipulates it to produce another text (XML4JSP) representation of it and returns this to TextTagBean.translateElement().

6. translateElement returns the text output of translateText to the SimpleTagBean.process() method.

7. The text representation is parsed into a DOM.

8. The top node of the new DOM replaces the element that was passed into translateElement().

Applicant asserts that various novel features of replacing an element/node in a DOM tree flagged by a custom tag are found in "Disclosure AUS8-1999-0727", as quoted above, which are then recited in the claims. For example, independent claim 1 recites the features of "upon encountering the tag, passing given information to a method in a tag handler ...", "having the method generate a string", "parsing the string into a new DOM tree", and "replacing the given node and any child nodes with the new DOM tree", which can be found by simple comparison in the subject matter that was quoted from "Disclosure AUS8-1999-0727".

The Office action further states:

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Eduardo Peligri-Lopart et al., JavaServer Pages™ Specification (Version 1.1 Public Release, August 18, 1999) reference.

It is unclear and confusing why this statement is included within the Office action. Applicant has provided evidence to show that the present invention was conceived and reduced to practice before the published reference.

It is also unclear if the Office action is objecting to the disclosure document as not providing sufficient evidence of a physical reduction to practice. It should be noted that the

disclosure document provides evidence of a constructive reduction to practice in the same manner that the specification document of a patent application provides evidence of a constructive reduction to practice. Moreover, the disclosure document
5 provides evidence of a conception of the invention prior to the effective date of the 08/18/1999-published reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application, as stated in 37 CFR 1.131.

10 The Office action either confuses the concepts of "derivation of work" with "reduction to practice" or implies that Applicant has confused the concepts when the Office action states:

15 Furthermore, Applicant's claim that he is named under "Acknowledgments" of the "'JavaServer Pages Specification' (8/18/1999)" does not serve as evidence of reduction to practice, as it does not indicate in what way and in what scope the inventor contributed to the disclosure.

20 Applicant did not make the statement about the "Acknowledgments" section in support of the concept of a reduction to practice. By including the statement about the "Acknowledgments" section of the prior art reference in "Exhibit A", Applicant was bringing to the attention of the USPTO that the JSP 1.1 reference is derived
25 from Applicant's own work. Applicant argues this issue in more detail hereinbelow.

The Office action also requests further information using the following statement:

30 Examiner requests Applicant to present any disclosures, publications, or sales information that have been cited in the IBM Invention Disclosure on pages 2-3 to conform with 37 CFR 1.105.

Applicant declines to provide further information at this time
35 because Applicant asserts that the Office action's inclusion of a

requirement under 37 CFR 1.105 for additional information is unreasonable for the following reasons and/or other reasons.

First, MPEP 704.11 states: "The criteria in 37 CFR 1.105 for making a requirement for information is that the information be
5 reasonably necessary to the examination or treatment of a matter in an application." Applicant asserts that there is no issue or matter in the present application such that the examination of the present application would be assisted by additional information. The Office action contains a statement in which it
10 appears that the Office action considered the 12/1999 date to be relevant, but as explained above, the 12/1999 date is irrelevant.

Second, MPEP 704.11 states: "There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter."
15 Applicant asserts that there is no reasonable basis for the 1.105 request for information. The Office action contains a statement that shows confusion with respect to the outstanding relevant issues, particularly the dates that are relevant to the issue of the reduction to practice of the present invention and the
20 publication date of a reference that partially forms the basis for the pending rejection of the claims in the present patent application. The 12/1999 date that is mentioned in the disclosure document is a date when it was expected that the invention that was disclosed within the disclosure document would
25 be included in an IBM product (IBM is the assignee of the present invention) at a time approximately around December 1999. As noted above, whether or not the present invention was actually included within the specified product at a date after the 08/18/1999 publication date is irrelevant. The fact of whether
30 or not there were "any disclosures, publications, or sales information" related to this mentioned product is irrelevant and

does not provide a reasonable basis for requesting such information.

Third, the statement in the Office action is misleading:

5 "Examiner requests Applicant to present any disclosures, publications, or sales information that have been cited in the IBM Invention Disclosure on pages 2-3 ...". Applicant asserts that the disclosure document does not cite such information; the disclosure document requests that the inventor provide such information as is known to the inventor at the time that the
10 inventor creates the disclosure document, and the inventor did not cite "any disclosures, publications, or sales information."

Fourth, the fact that there may have been some intention on the part of the assignee to prospectively include the present invention in a future product does not necessarily imply that the
15 present invention was described within "any disclosures, publications, or sales information" in any useful manner in any additional information within the relevant time frame, i.e. around the 08/18/1999 publication date of the applied reference.

Fifth, the disclosure document clearly contains information
20 that negates the 1.105 requirement for additional information. The disclosure document clearly cites "the identified product" as being "IBM internal". Given that the disclosure document states that the product is to be "IBM internal", there is no reasonable basis for assuming that there were "any disclosures, publications, or sales information" that were external to IBM and
25 available to parties other than IBM around the 08/18/1999 publication date of the applied reference.

Sixth, Applicant asserts that the 1.105 requirement for additional information in the Office action appears to be an
30 exercise to obtain additional information that hypothetically might raise an additional issue of an on-sale bar to the

patentability of the present invention or for some other similar issue. It should be self-evident that an attempt to obtain information in order to create an additional examination issue does not assist in the resolution of existing examination issues.

5 Seven, Applicant asserts that the 1.105 requirement is so vague and unclear in its present form that Applicant is not able to comply with the requirement. Applicant cannot comply with the requirement in the Office action that Applicant "... present any disclosures, publications, or sales information that have been
10 cited in the IBM Invention Disclosure on pages 2-3 ..." because no such information is cited. Applicant notes that the MPEP requires that a 1.105 requirement should be "narrowly defined". Given that it is unclear what additional information Applicant could present to clarify the issues concerning the 08/18/1999
15 publication of the applied reference, Applicant requests a clarification of the requirement if the 1.105 requirement is maintained.

20 **VI. Applicant's Declaration as Evidence of Derivation of Work**

MPEP 2132.01 states:

25 When the reference is not a statutory bar under 35 U.S.C. 102(b), (c), or (d), applicant can overcome the rejection by swearing back of the reference through the submission of an affidavit under 37 CFR 1.131. *In re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). If the reference is disclosing applicant's own work as derived from him or her, applicant may submit either a 37 CFR 1.131
30 affidavit to antedate the reference or a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

35 As discussed hereinabove, Applicant has submitted evidence that Applicant's conception of the claimed invention antedates

the applied reference. In addition, Applicant also asserts that it is unclear why the Office action has failed to consider that the pending obviousness rejection is improperly based on Applicant's own work. The pending rejection in the outstanding

5 Office action is an obviousness rejection under 35 U.S.C. §103(a). Any reference that is applied in a rejection under 35 U.S.C. §103(a) must be qualified as a prior art reference under one of the sections of 35 U.S.C. § 102. The applied JSP 1.1 reference qualifies as prior art under 35 U.S.C. § 102(a) because
10 the JSP 1.1 reference is a printed publication with a publication date prior to the filing date of the present patent application. However, Applicant can overcome a rejection based on the JSP 1.1 reference because the JSP 1.1 reference is derived from Applicant's own work.

15 Applicant's previously submitted affidavit clearly contains information sufficient to "to show derivation of the reference subject matter from applicant and invention by applicant" as stated in MPEP 2132.01. Although Applicant's previously submitted affidavit is titled as a 1.131 affidavit and MPEP
20 2132.01 requests a 1.132 affidavit, a 1.132 affidavit is merely a catch-all section that provides support for submission of affidavits that are otherwise "not provided for" in other regulatory sections; thus, the title of the affidavit is related to the other pending issues and irrelevant to the issue of
25 derivation of work. Hence, Applicant has properly submitted evidence to rebut the *prima facie* case that the JSP 1.1 reference describes work only "by others"; the JSP 1.1 reference clearly describes work by Applicant as noted in paragraph #4 of the affidavit and as acknowledged within the JSP 1.1 reference. In
30 other words, the relevant portions of the JSP 1.1 reference are derived from Applicant's own work. Applicant asserts that the